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IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

8 SUN MICROSYSTEMS INC, No. C-08-01641 EDL
9 Plaintiff, No. C-07-06053 EDL
No. C-07-05488 EDL

10 v.

11 NETWORK APPLIANCE,
12 Defendant.

**ORDER REGARDING OCTOBER 28,
2009 SUBMISSIONS FOLLOWING
COURT'S OCTOBER 14, 2009 ORDER**

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14 On October 14, in response to letter briefs raising discovery-related disputes, this Court
15 issued an Order allowing the following: (1) a joint statement regarding various privilege objections
16 made during the deposition of NetApp's in-house counsel, Gary Ross; (2) in camera review of an
17 allegedly privileged document NetApp claims was inadvertently produced; and (3) briefing
18 regarding NetApp's objection during Mr. Ross' deposition to a question about an Intel-NetApp
19 licensing agreement and Sun's subsequent demand for another 30(b)(6) witness on the topic. On
20 October 28 and 29, the parties submitted briefing as allowed by the Court's order. Having
21 considered the parties' positions on these issues, the Court rules as follows:

22 1. Privilege objections made by NetApp during Mr. Ross' deposition
23 a. Sun seeks an order compelling Mr. Ross to answer a question regarding who at
24 NetApp was involved in the selection of which patents would be asserted against Sun in the
25 September 2007 complaint. The information sought in this question is not privileged, though the
26 content of any discussions likely is. NetApp is hereby ordered to provide Sun with a list of
27 individuals directly involved in selecting which patents to assert against Sun in the September 2007
28 Complaint.
b. Regarding a question about royalty rates and historical royalty rates relating to certain

1 technology, Sun followed up by asking about the different fact situations that would determine a
2 royalty rate. NetApp objected that answering this question would require Mr. Ross to disclose
3 mental thoughts and impressions and required expert testimony. A response to this question does
4 not require expert testimony, but seeks information from Mr. Ross in his personal experience. Mr.
5 Ross is hereby compelled to answer the question, "What are the fact situations that you are aware of
6 in your personal experience that would determine whether or not a royalty rate is in the low single
7 digits or in the high teens?" His response may be limited to facts relating to his own personal
8 knowledge of business considerations, factors, and situations, and he need not respond to the extent
9 that his response would disclose legal considerations or relates to the impact of litigation or the
10 threat of litigation.

11 c. Sun seeks an order compelling a response to a question regarding communication
12 between Mr. Ross and Mr. Warmenhoven relating to patent licensing discussions between NetApp
13 and StorageTek in the 2002 timeframe. A response to this question, which seeks information shared
14 between a NetApp executive and in-house counsel regarding earlier licencing discussions that are
15 now relevant to this case, would reveal privileged information. Sun's request to compel this
16 information is denied.

17 2. NetApp has submitted a March 2004 email (NA0509588-92) from Mr. Ross to management
18 regarding his idea to establish a patent licensing program for NetApp's RAID DP technology for in
19 camera review to determine whether NetApp may "claw back" this document on the basis of
20 privilege. Having reviewed the document in question, the Court orders that the following
21 information therein is privileged and should be redacted:

- 22 • Page NA0509591: The two sentences that begin with the phrase, "We do not have to .
23 . . and end with "companies" under the "Target Audience" heading.
- 24 • Page NA0509591: The two sentences following the heading: "Restrictions:".
- 25 • Page NA0509591: The two sentences that begin with the phrase, "Another timing
26 issue . . ."
- 27 • Page NA0509592: The third full sentence at lines two to three of the page.

1 3. Both parties have submitted briefs regarding a dispute on two issues that arose during Mr.
2 Ross' deposition: was Mr. Ross adequately prepared as a 30(b)(6) witness to testify on the topics to
3 be covered; and was NetApp's objection to a question about whether DataONTAP was licenced to
4 Intel pursuant to a patent cross-license agreement valid. Regarding the first issue, a review of the
5 deposition transcript shows that Mr. Ross sufficiently answered the questions posed of him as a
6 30(b)(6) and Sun's demand for another witness on the topics covered is hereby denied. Regarding
7 the second issue, Sun's request for a further response is also denied. The agreement at issue was a
8 patent cross-license agreement, not a software license agreement, and Mr. Ross adequately testified
9 that NetApp had no position yet on whether DataONTAP was covered by the agreement.

10 4. Sun has also filed a two-page letter seeking leave to file an amended Reply to NetApp's
11 Answer and Counterclaims to include an "assignor estoppel" affirmative defense. Sun's letter does
12 not comply with the Court's 8/31/09 Order allowing the parties to submit "joint two-page letters to
13 the Court when discovery issues arise for which Court intervention appears necessary" (emphasis
14 added). A noticed motion is the proper vehicle for this request. Sun does not need leave of Court to
15 file a noticed motion to amend its reply.

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17 **IT IS SO ORDERED.**

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19 Dated: November 3, 2009



20 ELIZABETH D. LAPORTE
21 United States Magistrate Judge

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